

DOCKET NO. SP01-290
SERIAL NO. 09/972,469
FILED: OCTOBER 5, 2001
EXAMINER: CAROLYN L. SMITH
GROUP ART UNIT: 1631
CONFIRMATION NO. 4187

REMARKS

This paper is in response to a Notice of Noncompliant Amendment dated August 15, 2007. Applicant's representative thank the Examiner for bringing the discrepancies to Applicant's attention. The discrepancies have been corrected in claims 1 and 28 as suggested by the Examiner. The remainder of the remarks section correspond to the previously submitted amendment. The following substantive remarks are believed to be unaffected by the above-mentioned corrective amendments.

Claims 1-12 and 27-34 are pending, and claims 29-34 have been withdrawn in view of the restriction requirement. Claims 2 and 3 has been canceled without prejudice or disclaimer. Applicant reserves the right to pursue any canceled claims in a continuation or divisional application, or by rejoinder as appropriate. Claims 1, 11, and 28 have been amended as indicated. Applicant respectfully submits that the amendments to the claims do not introduce new matter. Accordingly, entry of the amendments is respectfully requested.

Claim Rejection Under 35 U.S.C. §112, Second Paragraph

Claims 1-12 and 27-28 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite and claims 2-12 and 27 for depending from claim 1. The phrase "to a substrate of an assay" in claims 1 and 28 have been replaced with "on a substrate to form an array". Claims 2, 3, and 11 were also rejected for the phrase "said amplified sequence". Claims 2 and 3 were canceled and claim 11 was amended to delete the phrase as indicated and to render the rejection moot.

Claim Rejection Under 35 U.S.C. §102(a)

Claims 1-2, 5-10, 12, and 27-28 were rejected under 35 U.S.C. §102(a) as allegedly being anticipated by U.S. Patent No. 6,274,332 ("*Keating*"). The rejection is respectfully traversed.

Applicant respectfully submits that *Keating* fails to describe each and every element of the independent method claims 1 and 28. *Keating* describes a two stage PCR amplification of genomic sequences followed by sequencing for detecting mutations (e.g., col. 56, line 53 to col. 57, line 13). *Keating*, however, does not disclose amplifying genomic sequences from 3'UTR regions nor does *Keating* disclose printing the amplified sequences on a substrate to make DNA arrays. Rather, *Keating* uses preformed DNA microarrays for screening the amplified and sequenced products instead of making an array as in the recited method claims. Accordingly,

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Applicant respectfully submits that *Keating* fails to mention each and every element of claim 1 or claim 28 and therefore cannot anticipate the recited claims.

Because claims 2-12 and 27 depend from claim 1, Applicant submits that *Keating* also fails to disclose each and every element of the dependent claims. For the above reasons, Applicant respectfully requests reconsideration and withdrawal of the §102(a) rejection.


CONCLUSION

For at least the reasons set forth above, Applicant respectfully submits that this application is in condition for allowance. Favorable consideration and prompt allowance of the claims are earnestly solicited. Although Applicant believes that no fee is due, the Commissioner is hereby authorized to charge any payment deficiency to deposit account number 03-3325.

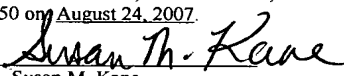
Should the Examiner believe that anything further is desired in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

Date: August 24, 2007



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<p>CERTIFICATE OF MAILING (37 CFR 1.8a)</p> <p>I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on <u>August 24, 2007</u>.</p> <p> _____ Susan M. Kane</p>
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